

Remarks/Arguments

The Office has provisionally rejected claims 1, 9 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10 and 19 of co-pending Application No. 10/106,699 ('699). Additionally, the Office has rejected claims 1, 9 and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12 and 23 of Patent No. 6,772,163 ('163). Also, the Office has rejected claims 1-7, 9-16 and 18-24 under the 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,092,061 (Choy). Finally, the Office has noted that claims 8, 17 and 25 would be allowable if they were rewritten in independent form, including all of the limitations of their respective base and intervening claims.

Provisional Obviousness-type Double Patenting Rejections Over the '699 Application

Applicant acknowledges receipt of the Office's provisional, obviousness-type double patenting rejection of claims 1, 9, and 18 and will reserve any argument or commentary until such time as one of the two applications issues and the provisional nature of the double-patenting rejection ends.

Obviousness-type Double Patenting Rejections Over the '163 Patent

A terminal disclaimer (PTO/SB/26) is attached to this paper in response to the Office's double patenting rejection of claims 1, 9, and 18 of the subject application over the '163 patent.

The 102(b) Rejections in View of Choy

With respect to claim 1, Choy does not teach or suggest a method for creating a "file context" or for "determining the lowest first value stored by the file context," as required by Applicant. While, as the Office notes (*see* Office action, page 13), the index of Choy may have a "lowest first value" (e.g., Employee No. "01"), as is the case with

any compilation of data, it would be readily apparent to anyone of ordinary skill in this technology area that an index having a lowest first value is not at all the same as a process step that *determines* what that lowest first value is. Further, while the database management system (DBMS) of Choy "typically *maintains* an index" (*see* Choy, col. 6, line 18) (emphasis added), as the Office has noted (page 12), this permanently stored index is not at all the same as Applicant's "file context," which is a temporary device that exists in memory only during method operation. In so far as it does not teach or suggest determining a lowest first value, or creating a file context, Choy does not meet the limitations of Applicant's claim 1. Therefore claim 1, and claims 2 through 8 which depend from claim 1, are patentable over Choy.

Similarly, applying the arguments above to Applicant's claim 9, it is seen that Choy does not teach or suggest "creating a file context" or "determining the lowest first value stored by the file contexts," as required by Applicant. In so far as Choy does not teach or suggest creating file contexts or determining a lowest first value stored by the file contexts, Choy does not meet the limitations of Applicant's claim 9. Therefore, claim 9, and claims 10 through 17 which depend from claim 9, are patentable over Choy.

Finally, applying this reasoning to claim 18, it is also seen that Choy does not teach or suggest a computer program to "create a file context" or to "determine the lowest first value stored by the file contexts," as required by Applicant. As Choy does not teach or suggest all the limitations of Applicant's claim 18, this claim and the claims that depend from it all are patentable over Choy.

Conclusions

As noted above, Applicant has attached a terminal disclaimer to address the double patenting rejection of the subject application over the '163 patent. Further, Applicant acknowledges receipt of the Office's provisional rejection of claims 1, 9, and 18 with comment reserved until such time as comment or action becomes necessary. Finally, and for the reasons discussed above, all of Applicant's claims are allowable over Choy.

In light of the above, Applicant asks the Office to reconsider this application and to allow all of the claims. Please apply any charges that might be due, excepting the issue fee but including fees for extensions of time, to deposit account 50-1673.

Respectfully,



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